REMARKS

Reconsideration of this application is respectfully requested. Applicant has addressed every ground for rejection in the Office Action dated January 9, 2004, Paper No. 3, and believes the application is now in condition for allowance.

The present invention relates to a poker game and method for playing the same that allows a player to place an initial wager that the final hand will be a winning hand and to place a second wager, after the initial cards are dealt, that the final hand with contain a specific card combination. In particular, the player places an initial wager that bets that the final hand will contain any one of the preselected winning card combinations. Once the bet is placed, an initial hand of cards is dealt to the player. After the cards are dealt, the player may then elect to place a second wager, which is independent from the initial wager, to bet that the final hand will contain a particular combination of cards. If the final hand contains the particular combination of cards that the player bet on, then the player wins both the initial and second wager. However, if the final hand does not match the particular combination of cards, but does match one of the preselected winning card combinations, then the player will win the initial wager, but lose the second wager.

Claims 1-10 and 15-18 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In particular, the Examiner stated that there is insufficient antecedent basis for the use of the limitation "the player" as set forth in the preamble in Claims 1, 6 and 15. Claims 1, 6 and 15 have been amended to change "the player" to "a player." Accordingly, it is respectfully submitted that this rejection is traversed

Claims 1-18 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,416,407 to Carrico et al. in view of Roberts U.S. Patent No. 5,636,843. The Examiner stated that it would be obvious to combine the teaching of placing side bets prior to the cards being dealt taught in Roberts with the draw poker game taught in Carrico. For the reasons set forth herewithin, this rejection is traversed. In particular, it is respectively submitted that there is absolutely no teaching, motivation or suggestion in the cited references to place a proposition bet after the cards are dealt.

The Carrico patent discloses a multi-draw poker game wherein a player places an original wager and is dealt five cards. If the cards represent a winning hand, the player may elect to halt play and collect his winnings, or elect to draw additional cards. After the cards are drawn, the player may again elect to either halt play or draw additional cards. If player elects to draw additional cards, then the player must pay an amount equal to the player's original wager plus an amount equal to any potential winnings the player would have won after the first cards were drawn. In other words, the player must give up a potentially winning hand and potential payoff from an initial winning hand to make the additional wager. [See Col. 6, lines 3-6 ("The player is induced to give up the winning hand and potential payout from that winning hand . . . to make the additional wager . . ."]. The player wins if the final hand matches any one of the predetermined winning poker hands (other than the initial winning hand).

Roberts teaches a method of playing cards wherein a player may make one or more side bets on the outcome of the hand prior to the cards being dealt. [See, e.g., Col. 2, lines 3-8 ("It is an important object to . . . define a card combination and other betting conditions against which a wager is made prior to beginning play of each hand . . . ." (emphasis added)]. There is absolutely no teaching in the patent to suggest placing any bets on the specific outcome of the game after

the cards are dealt. Furthermore, it would be counterintuitive to allow bets to be placed on the specific outcome of the hand after cards have been dealt as the player would have a better idea of the outcome of the hand, and thus a better chance of winning the particular bet.

In order to establish a *prima facie* case of obviousness, the Examiner must establish that a prior art reference or references teach or suggest all of the claimed limitations; there is some suggestion or motivation to modify the prior art to obtain the claimed invention; and there is a reasonable expectation of success. M.P.E.P. §706.02(j).

The obviousness analysis focuses on the differences or changes between the claimed subject matter of the application and the subject matter contained within the prior art references at the time of the invention. Regardless of the simplicity of the changes, the claimed subject matter will be patentable if the prior art fails to teach, suggest or motivate one of ordinary skill in the art to modify what was known in the prior art, including any personal knowledge, to obtain the claimed subject matter. In particular, the Federal Circuit has stressed that

> [i]n a proper obviousness determination, [w]hether the changes from the prior art are minor, . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's device. This includes what could be characterized as simple changes . . . .

In re Chu, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995) (citations omitted).

In the present case, none of the cited prior art teaches or suggests offering proposition bets after the cards are dealt. It is respectfully submitted that in order to get around the lack of teaching in the prior art, the Examiner has resorted to hindsight. As noted by the Examiner, Roberts teaches placing proposition bets prior to the cards being dealt. Accordingly, the players must simply base their bets on a guess, as they have no actual idea what cards they will be dealt. As the Examiner notes, the claimed invention offers a player the opportunity to make an

"educated wager" in that he or she will know at least some of the cards that they have prior to making the bet. However, it is respectfully submitted that the Examiner is improperly looking to the teachings of the claimed invention—rather than the prior art—in making her determination of obviousness as there is absolutely no teaching or suggestion of placing proposition bets *after* the cards are dealt in the cited art. Further, Carrico teaches against the use of separate proposition bets as it requires the player to *give up any potential winnings of the second hand* if the player elects to draw any additional cards. In the present invention, the placing of a proposition bet does not affect the outcome of the initial bet. On the contrary, in the present invention, the proposition bet is an additional opportunity for a winning bet. As there is no teaching of offering separate proposition bets *after* the cards are dealt without the need to forfeit any winnings, and there is no motivation or suggestion in the prior art to combine the references, it is respectfully submitted that Claims 1-18 are patentable over the prior art of record. Accordingly, the present rejection should be withdrawn and the claims allowed to issue.

Should the Examiner discover that there are remaining issues that could be resolved by an interview, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

June 24, 2004

Respectfully submitted,

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IN THE
UNITED STATES
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ART UNIT:	AU3713

AMENDMENT AND COMMUNICATION; REQUEST FOR EXTENSION OF TIME; FEE TRANSMITTAL; AND FILING FEE

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Date of Deposit: June 24, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service, "First Class Mail" service in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on June 24, 2004.

Dated: June 24, 2004

Max Shaftal